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FERRELLS, PLLC P. O. BOX 312 CLIFTON, VA 20124-1706			JACOBSON, MICHELE LYNN	
			ART UNIT	PAPER NUMBER
			1782	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/591,771

## Applicant(s)

LEE ET AL.

## Examiner

Michele L. Jacobson

## Art Unit

1782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-58, 60-71 and 73-79 is/are pending in the application.
- 4a) Of the above claim(s) 29-49, 71, 73-77 and 79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28, 50-58, 60-70 and 78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Examiner Notes***

1. Any objections and/or rejections made in the previous action, and not repeated below, are hereby withdrawn.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 57, 58, 61 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 57 and 58 recite "wherein said cyclo-olefin copolymer comprises" proportions of norbornene and ethylene. However, claims 56, from which claims 57 and 58 depend recites that the "cyclo-olefin copolymer consists essentially of the residue of norbornene and ethylene". Therefore, the open ended phrase "comprises" in claims 57 and 58 contradicts the more limited phrase "consists essentially of" recited in claim 56. Therefore, one of ordinary skill in the art would not be reasonably apprised of the full

scope and breadth of the invention claimed. For the purpose of examination, claims 57 and 58 will be interpreted to recite "consisting essentially of". Appropriate correction is required.

5. Similar to the indefiniteness of claims 57 and 58, claims 61 and 62 also recite the phrase "comprises" whereas the claim from which they depend, claim 50, recites "consists essentially of". For the purpose of examination, claims 61 and 62 will be interpreted to recite "consisting essentially of". Appropriate correction is required.

### ***Claim Objections***

6. Claims 1 and 44 are objected to because of the following informalities:

7. Claim 1 recites "with the further proviso". The word "proviso" as defined by Merriam-Webster dictionary means "an article or clause (as in a contract) that introduces a condition" or "a conditional stipulation". This word is not appropriate for defining an invention in a patent claim because a patent claim is not a contract but a definition of the scope of intellectual property protection being sought. The examiner suggests that the phrase "with the further proviso" be replaced with "and wherein". Appropriate correction is required.

8. Claim 44 is marked "original" in the instantly pending claim set submitted 5/16/11. Claim 44 is drawn to an unelected method and therefore should be marked "withdrawn". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-15, 18-21, 23, 24, 50-58, 60-63, 65-67, 70 and 78 are rejected under 35 U.S.C. 102(e) as being anticipated by Saavedra et al. U.S. Patent Application Publication No. 2006/0057410 (hereafter referred to as Saavedra) and evidentiary references "Butadiene" Sun, H. N. and Wristers, J. P. 2002. Butadiene. Kirk-Othmer Encyclopedia of Chemical Technology. (hereafter referred to as Sun) , Matweb data sheet for Chevron Phillips K-resin® DK11 Styrene Butadiene copolymer and Wolf et al. U.S. Patent No. 6,406,763.

11. Saavedra teaches a multilayer film comprising at least three layers: an inner layer between two skin layers. (Para. 11) The inner layer may comprise cyclic-olefin copolymer. (Para. 11) The skin layers may comprise styrene-butadiene copolymer. (Para. 11) One or two intermediate layers may be disposed between the skin layers and the inner layer. (Para. 27) The intermediate layers may be the same resins or different. (Para. 27)

12. The cyclic olefin copolymer(COC) recited are amorphous, glass-clear copolymers of ethylene and norbornene which provide good stiffness and high clarity such as Topas® COC copolymers. (Para. 24) Topas ® 8007 is disclosed to be useful. (Para. 40)

13. The styrene-butadiene copolymers (SBC) disclosed are clear resins known in the art. (Para. 23) The SBC resin provides both high clarity and good film stiffness. (Para. 23) Useful SBC are disclosed to include DK11 and DK13 available from Chevron-Phillips. (Para. 40)

14. Saavedra discloses that film clarity is highly influenced by the skin layers and that for higher clarity embodiments of the inventive film the skin layers preferably comprise SBC or COC. (Para. 30). For retail, high clarity films of the inventive film preferably have a haze value of less than 5% as measured by ASTM D-1003. (Para. 33)

15. The films disclosed may be made by coextrusion. (Para. 36) Layer ratios of the three layer embodiment are disclosed to include 15:70:15. (Para. 41)

16. Regarding claims 1, 50, 61, 62 and 78: Saavedra discloses a multilayer film comprising a COC layer melt bonded (coextruded) directly to two outer skin (outermost) layers comprising SBC wherein the COC is a copolymer of ethylene and norbornene as claimed in claims 1, 50 and 78. The SBC skin layers disclosed by Saavedra are interpreted to be "substantially free of cyclic olefin" as claimed in claim 1 since they are not disclosed to be comprised of cyclic olefin. Wolf et al. U.S. Patent No. 6,406,763 discloses that the SBC DK11 contains about 75 wt% styrene monomer and 25 wt% butadiene monomer. (Col. 14, lines 45-49) Therefore, a laminate comprising SBC

DK11 as the skin layers as disclosed by Saavedra anticipates the compositional limitations of the SBC layer recited in claims 1, 50, 61, 62 and 78. Likewise, the COC inner layer of Saavedra is interpreted to be "substantially free of styrene butadiene copolymer" as claimed in claim 1 since it is not disclosed to further comprise SBC. Therefore, Saavedra anticipates all of the limitations of claims 1, 50 and 78.

17. Regarding claim 2: Saavedra does not disclose that halogens are present in the film recited and therefore the film of Saavedra is interpreted to be "substantially free of halogens as claimed in claim 2.

18. Regarding claims 3-6: Saavedra discloses coextrusion of the three layers of the film and therefore the SBC skin layers are extruded simultaneously and in contact with the COC inner layer as claimed in claims 3-6.

19. Regarding claims 7-9: Saavedra discloses that additional intermediate layers comprising the same resin may be present between the skin layers and the inner layer as claimed in claims 7-9.

20. Regarding claim 10: Saavedra is silent regarding whether the styrene butadiene copolymer disclosed "comprises the reaction product of: a styrene monomer and 1,3-butadiene" as claimed in claim 10. However, the examiner takes official notice that it was universally known in the polymer arts that the disclosure of styrene butadiene copolymer means a copolymer that comprises the reaction products of a styrene monomer and 1,3-butadiene as evidenced by "Butadiene" Sun, H. N. and Wristers, J. P. 2002. Butadiene. Kirk-Othmer Encyclopedia of Chemical Technology. (hereafter referred to as Sun) Sun teaches "Butadiene exists in two isomeric forms: 1,3-butadiene

and 1,2-butadiene" and that "1,2-butadiene, a small by-product in 1,3-butadiene production, has no significant current commercial interests" (Pg. 1) As such, one of ordinary skill in the art would have immediately envisaged that a generic recitation of butadiene would mean 1,3-butadiene since the only other form butadiene exists in has no commercial interests. Therefore, the SBC of Saavedra comprises styrene and 1,3-butadiene monomers and anticipates the limitations of claim 10.

21. Regarding claims 11-15 and 18-20: The COC of Saavedra comprising ethylene and norbornene anticipates the limitations of claims 11-15 and 18-20.

22. Regarding claim 21: Saavedra discloses that Topas® 8007, the COC resin useful for the invention has a density of 1.020 g/cm<sup>3</sup>. (Para. 40) Matweb data for DK11 styrene-butadiene copolymer which is disclosed by Saavedra to be a useful SBC for the invention teaches that the density of DK11 is 1.01 g/cm<sup>3</sup>. (Matweb data sheet) Therefore, a three layer film having skin layers of DK 11 SBC and a core layer of Topas® 8007 COC resin would have to have a density between 1.01 and 1.02 g/cm<sup>3</sup>. This density anticipates points within the range claimed in claim 21.

23. Regarding claims 23: The film of Saavedra is made of the same materials as disclosed by applicant and it therefore naturally flows that it would display the same characteristics of WVTR claimed in claim 23.

24. Regarding claim 24: The film of Saavedra has very low haze, is disclosed to have high clarity and is comprised of the same materials as the film claimed by applicant. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the



prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) (MPEP 2112.01 II) Therefore, it naturally flows that the film of Saavedra would display a light transmission value as claimed in claim 24.

25. Regarding claim 51: Saavedra does not disclose that the COC core layer recited comprises any further resins and therefore it is interpreted to "consist essentially of COC" as claimed in claim 51. While it is recognized that the phrase "consisting essentially of" narrows the scope of the claims to the specified elements and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, "consisting essentially of" is construed as equivalent to "comprising". Further, the burden is on the applicant to show that the additional ingredients in the prior art would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant's invention. See MPEP 2111.03.

26. Regarding claims 52-56: The COC comprising ethylene and norbornene disclosed by Saavedra anticipates the limitations of claims 52-56.

27. Regarding claims 57 and 58: Saavedra discloses that Topas® 8007 is a useful COC for the invention. Applicant's specification discloses that Topas® 8007 is a useful COC for the instantly claimed invention and that this resin contains 36 mol% norbornene with the balance being ethylene. (Pg. 34, lines 28-29) Therefore, the Topas® 8007 COC resin disclosed by Saavedra anticipates the limitations of claims 57 and 58.

28. Regarding claim 60: Saavedra does not disclose that the SBC recited comprises and further monomers and therefore the SBC of Saavedra is interpreted to consist of styrene and butadiene residues as claimed in claim 60.

29. Regarding claim 63: Saavedra discloses that each skin layer comprises 15% of the total laminate thickness. Therefore, the core layer is 4.6 times thicker than the skin layer which anticipates the limitations of claim 63.

30. Regarding claims 65-67: Saavedra anticipates the three layer embodiment and the coextruded embodiment claimed in claims 65 and 66. The recitation of "lamination" in claim 67 is given little patentable weight and it interpreted to read on coextrusion. Even if the term "lamination" were interpreted to imply that the layers of the laminate were formed separately and then melt bonded together, this limitation would merely be a product by process limitation that fails to provide any structural features which would render the invention claimed materially distinguishable from that disclosed in the prior art. Saavedra therefore anticipates the limitations of claim 67.

31. Regarding claim 70: The film of Saavedra is disclosed to have a haze of less than 5% and the SBC and COC disclosed to make the film of Saavedra are disclosed to be particularly advantageous for films requiring high clarity and the materials disclosed by Saavedra are the same as those claimed by applicant. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir.

1990) (MPEP 2112.01 II) Therefore, it naturally flows that the film of Saavedra would inherently exhibit a correlated haze as claimed in claim 70 when produced at a thickness as recited in claim 70.

***Claim Rejections - 35 USC § 103***

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

33. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saavedra et al. WO 2004/024433, U.S. Patent Application Publication No. 2006/0057410 (hereafter referred to as Saavedra) as applied to claims 1 and 50 above in further view of "Radiation Curing" McGinniss, V. D. 2000. Radiation Curing. Kirk-Othmer Encyclopedia of Chemical Technology (hereafter referred to as McGinniss).

34. Saavedra teaches what has been recited above but is silent regarding the COC layer comprising a cross-linker.

35. McGinniss teaches that cross-linked polymer has higher melting points, improved heat resistance and improved chemical resistance than the original thermoplastic

polymer. (Pg. 1) Cross-linking of polymeric materials can be facilitated by the use of cross-linking agents such as alkenes. (Pg. 5)

36. McGinniss evidences that it was universally known in the art at the time the invention was made that cross-linking polymeric materials provided improved properties and that cross-linking can be accomplished by the use of cross linking agents such as alkenes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included an alkene cross linking agent in the COC layer of Saavedra in order to increase the melting point, improve the heat resistance and improve the chemical resistance of the film disclosed. This obvious use of a technique well known in the art would have produced the invention claimed in claims 16 and 17.

37. Claims 22-28, 64, 68 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saavedra et al. WO 2004/024433, U.S. Patent Application Publication No. 2006/0057410 (hereafter referred to as Saavedra) as applied to claims 1 and 50 above.

38. Saavedra teaches what has been recited above but is silent regarding the peel strength between the layers recited and the thickness of the layers of the film.

39. Regarding claims 22, 68 and 69: It would have been obvious to one having ordinary skill in the art at the time the invention was made who desired to prevent peeling of the layers of the laminate disclosed by Saavedra from one another to have disposed an adhesive material between the layers disclosed. It is universally known in

the laminate arts to employ polymeric adhesives to increase the bond strength between laminate layers. The use of a universally known technique to increase the adhesion of polymeric layers would have produced the invention as claimed in claims 21, 68 and 69.

40. Regarding claim 25: Saavedra discloses that the film of the invention has a haze of less than 5% which overlaps or encompasses the range claimed in claim 25. In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990)

41. Regarding claims 26-28 and 64: Saavedra is silent regarding the thickness of the layers of the film disclosed. However, it has long been an axiom of United States patent law that it is not inventive to discover the optimum or workable ranges of result-effective variables by routine experimentation. *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003) ("The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages."); *In re Boesch*, 617 F.2d 272, 276 (CCPA 1980) ("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art."); *In re Aller*, 220 F.2d 454, 456 (CCPA 1955) ("[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."). "Only if the 'results of optimizing a variable' are 'unexpectedly good' can a patent be obtained for the claimed critical range." *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997) (quoting *In re Antonie*, 559 F.2d 618, 620 (CCPA 1977)).

42. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the layers of the laminate disclosed by Saavedra whatever thickness was desired depending on the application the film was intended to be used for. Obviously, thicker layers are going to be tougher. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have optimized the layer thicknesses of the layers disclosed. This obvious optimization of the thickness of the layers would have produced the same invention as claimed in claims 26-28 and 64.

### ***Response to Arguments***

43. Applicant's arguments filed 3/30/11 have been fully considered but they are not persuasive.

44. Applicant's arguments on pages 22, 26 and 27 of the remarks regarding the unity of invention of the instantly pending claims is not found persuasive since as explained above, Saavedra teaches the corresponding special technical feature that is shared between groups I, II and III.

45. Applicant's assertions regarding unexpected results on page 25 of the remarks are not germane to an anticipation rejection. Secondary considerations (i.e. unexpected results) are only relevant to rebut a case of *prima facie* obviousness.

46. Applicant appears to assert on pages 25 and 26 of the remarks that because Saavedra discloses multiple embodiments that the instantly claimed invention cannot be anticipated. However, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele L. Jacobson whose telephone number is (571)272-8905. The examiner can normally be reached on Monday-Thursday 8:30 AM-6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele L Jacobson/  
Examiner, Art Unit 1782

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